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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,666

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Troy J. Chapman

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EXAMINER

LEE, BENJAMIN HYOUNGSOL

ART UNIT

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3739

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,666	Applicant(s) CHAPMAN ET AL.	
	Examiner BENJAMIN LEE	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/21/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In response to the amendment filed on 10/21/09, claims 1-5 and 7-14 are pending and claim 6 is canceled. The claim objections, 35 USC 112 rejections, and nonstatutory double patenting rejections have been withdrawn in view of the amendment and terminal disclaimer.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-2, 5, 7, 9-10 and 13-14** are rejected under 35 U.S.C. 102(b) as being anticipated by Tetzlaff (U.S. Pat. No. 6,277,117 B1).

As to claim 1, Tetzlaff discloses an electrode sealing assembly designed for use with an electrosurgical instrument for sealing tissue, comprising: first and second jaw members 22, 24 each having an electrically insulative housing including at least one electromechanical interface and being movable from a first position in spaced relation relative to one another to at least one second position for grasping tissue therebetween (col. 3, ln. 52-59 and Figs. 1,2, and 8), each of the jaw members including: an electrically conductive sealing plate 115, 125 having at least one corresponding electromechanical interface which mates with the electromechanical interface of the insulative housing (Figs. 5-7); a thermally conductive, electrically non-conductive

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material 111, 121 disposed between the insulative housing and the electrically conductive sealing plate, the thermally conductive, electrically non-conductive material configured to engage at least one side of said sealing plate (Figs. 5-7); wherein the thermally conductive, electrically nonconductive material of at least one jaw member includes projections 122 that extend laterally therefrom (see Fig. 5). Note that they extend laterally depending on the orientation a user holds the assembly (e.g., the projections extend laterally from the thermally conductive, electrically nonconductive material when clamping a vertical plane of tissue).

As to claim 2, Tetzlaff discloses the thermally conductive, electrically non-conductive material is configured to encapsulate and secure the sealing plate to the electrically insulative housing (col. 6, ln. 36-41).

As to claim 5, Tetzlaff discloses the thermally conductive, electrically non-conductive material of at least one jaw member is at least one of thermally conductive plastic and anodized aluminum (col. 6, ln. 41-42).

As to claim 7, Tetzlaff discloses the electrically conductive sealing plate of at least one jaw member includes at least one stop member 101 for controlling the distance between jaw members (col. 7, ln. 55-60 and Fig. 3).

As to claim 9, Tetzlaff discloses the jaw members are disposed at an angle relative to a shaft of the electrosurgical instrument (see Fig. 1).

As to claim 10, Tetzlaff discloses the electrode sealing assembly is disposable (abstract).

As to claim 13, Tetzlaff discloses an electrode sealing assembly designed for use with

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an electrosurgical instrument for sealing tissue, comprising: first and second jaw members 22, 24 being movable from a first position in spaced relation relative to one another to at least one second position for grasping tissue therebetween (col. 3, ln. 52-59 and Figs. 1,2, and 8), each of the jaw members including: an electrically conductive sealing plate 115, 125 (Figs. 5-7); and a thermally conductive, electrically non-conductive material 111, 121 being configured to engage a side of the sealing plate (Figs. 5-7), wherein the thermally conductive, electrically nonconductive material of at least one jaw member includes projections 122 that extend laterally therefrom (see Fig. 5). Note that they extend laterally depending on the orientation a user holds the assembly (e.g., the projections extend laterally from the thermally conductive, electrically nonconductive material when clamping a vertical plane of tissue).

As to claim 14, Tetzlaff discloses the thermally conductive, electrically non-conductive material is configured to encapsulate and secure the sealing plate to an electrically insulative housing (col. 6, ln. 36-41).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claim 4** is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tetzlaff ('117).

As to claim 4, since electrosurgical forceps with insulated housings are well-known in the art in order to limit treatment to the exposed electrode portions, it would be obvious, if not inherent, to use one of the well-known materials specified in claim 4 to make the insulative housing of Tetzlaff.

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8. **Claims 3, 8, and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff ('117) in view of Schmidt (U.S. Pat. No. 5,456,684).

As to claim 3, Tetzlaff discloses the electrode sealing assembly according to claim 1, wherein the thermally conductive, electrically non-conductive material of at least one jaw member includes first and second segments which join to the sealing plate. Each of the snap-fit engagements of the thermally conductive, electrically non-conductive material 121 (Fig. 6) that can be of male configuration (col. 4, ln. 6-9) comprises a segment that joins to the sealing plate. The claim differs from Tetzlaff in calling for the joining to encapsulate the sealing plate. Schmidt, however, teaches having the insulating member 100, 106 encapsulate the electrically conductive sealing plate 180, 182 (Figs. 3-5) as an advantageous way of forming insulated forceps for treating tissue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the first and second snap-fit segments of the thermally conductive, electrically non-conductive material of Tetzlaff to join to the sealing plate to encapsulate the sealing plate as an advantageous way of forming insulated forceps for treating tissue that is known in the art.

As to claim 8, Tetzlaff discloses the electrode sealing assembly according to claim 1, wherein the thermally conductive, electrically non-conductive material is overmolded to capture the electrically conductive sealing plate (col. 6, ln. 36-41). Tetzlaff does not expressly disclose that the overmolded surface of the thermally conductive, electrically non-conductive material forms a tissue contacting surface that is substantially flush with the tissue contacting surface of the electrically conductive sealing plate. Schmidt,

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however, teaches molding a thermally conductive, electrically non- conductive material 100, 106 over an electrically conductive sealing plate 180,182 to form a tissue contacting surface that is substantially flush with the tissue contacting surface of the electrically conductive sealing plate (col. 6, ln. 31-48 and Figs. 3-5) as an advantageous way of forming insulated forceps for treating tissue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have molded the thermally conductive, electrically non-conductive material over the electrically conductive sealing plate of Tetzlaff in accordance with claim 8 in view of the teaching of Schmidt as an advantageous way of forming insulated forceps for treating tissue that is known in the art.

As to claim 12, Tetzlaff discloses an electrode sealing assembly designed for use with an electrosurgical instrument for sealing tissue, comprising: first and second jaw members 22, 24 being movable from a first position in spaced relation relative to one another to at least one second position for grasping tissue therebetween (col. 3, ln. 52-59 and Figs. 1,2, and 8), each of the jaw members including: an electrically insulative housing having at least one electromechanical interface; an electrically conductive sealing plate 115, 125 having at least one corresponding electromechanical interface which mates with the electromechanical interface of the insulative housing (Figs. 5-7), at least one of the sealing plates of at least one of the jaw members including at least one stop 101 member which extends therefrom (col. 7, ln. 55-60 and Fig. 3); and first and second thermally conductive, electrically non-conductive segments disposed between the insulative housing and the electrically conductive sealing plate, the thermally

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conductive, electrically non-conductive segments being joinable to encapsulate and secure the sealing plate to the insulative housing. As stated in the preceding rejection of claim 3, the snap-fit segments of the thermally conductive, electrically non-conductive material 121 join to encapsulate the sealing plate 125 in view of Schmidt. In addition, snap fit segments on the opposite side of material 121 join to secure the sealing plate to the insulative housing (Figs 5-7). Tetzlaff discloses the thermally conductive, electrically nonconductive material of at least one jaw member includes projections 122 that extend laterally therefrom (see Fig. 5). Note that they extend laterally depending on the orientation a user holds the assembly (e.g., the projections extend laterally from the thermally conductive, electrically nonconductive material when clamping a vertical plane of tissue).

Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stern et al. (5443463), Kliceck (5496312), Hooven (6086586), Wampler (6676660), Truckai (6773409), Baker (6926716), Phan (6932816), Yates

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(5688270, 5810811, 5709680, 5716366, 5833690), Yamauchi (6273887), Tetzlaff (6511480, 20040236325), Lawes (20040176762).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN LEE whose telephone number is (571)270-1407. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571)-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. L./ 12/4/09
Examiner, Art Unit 3739

/Linda C Dvorak/
Supervisory Patent Examiner, Art
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